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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,535	11/09/2001	Nobunao Ikewaki	215051US0	5778

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EXAMINER	
LEWIS, PATRICK T	

ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/986,535	IKEWAKI ET AL.	
	Examiner	Art Unit	
	Patrick T. Lewis	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3 and 5-23* is/are pending in the application.

4a) Of the above claim(s) *16-21* is/are withdrawn from consideration.

5)☒ Claim(s) *3 and 5-8* is/are allowed.

6)☒ Claim(s) *1,9-11,13-15,22 and 23* is/are rejected.

7)☒ Claim(s) *12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on December 18, 2002 is acknowledged. The requirement was made FINAL in the Office Action dated March 21, 2003.

2. Claims 16-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 16, 2002.

Response to Amendment

3. The declaration under 37 CFR 1.132 filed July 16, 2004 is insufficient to overcome the rejection of claims 1, 9-15, and 22-23 based upon a specific reference applied under 35 U.S.C. 102 or 103 as set forth in the last Office action because: the declaration submitted to demonstrate unexpected results or properties does not compare the closest prior art relied upon and the claimed invention. The results presented compared properties of β-1,3-1,6-glucans obtained from *Aureobasidium* strain FERM P-18099 (instantly claimed) medium and *Aureobasidium* strain P-4257 (control used by applicant but not a strain disclosed in the prior art of record).

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamada et al. (1983), Vol. 47, pages 1167-1172 (Hamada).

Hamada discloses that an acidic polysaccharide is isolated from the culture broth of *Aureobasidium sp.* K-1. See abstract. Hamada discloses on page 1170, left column, last sentence of the first paragraph, that this polysaccharide "consists of a backbone of β-1,3-linked glucose residues with β-linked single glucose units attached, roughly three out of four glucose residues at the O-6 positions in the backbone." See also Figure 4 on the top of page 1171. Finally, on page 1167, right column, first complete sentence, Hamada teaches that the polysaccharide produced under the disclosed conditions was about 4 mg per mL of broth.

The source of β-1,3-1,6-glucans as instantly claimed is not seen to result in a patentably distinguishable chemical structure. Applicant has failed to particularly point

out and distinctly claim the subject matter which applicant regards as the invention in such a way as to distinguish the instant invention over the prior art. The asserted characteristics differentiating the instantly claimed β-1,3-1,6-glucans from glucans obtained from other strains of Aureobasidium is not recited in the claims. Since the Office does not have the facilities for preparing the claimed materials and comparing when with prior art inventions, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

7. Claims 1, 9-11, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Watanabe et al. JP 06-340701 (Watanabe).

Watanabe discloses that β-glucans are obtained by inoculating *Aureobasidium pullans* IFO 4466 strain in a liquid medium. See Abstract. In the Figure with the Abstract, Watanabe discloses that the β-glucans are 1,3-1,6-glucans. Finally, Watanabe discloses that the β-glucan can be used in medicines, i.e. pharmaceutical compositions, and food additives, i.e. food products, by adding an organic solvent to the culture solution of *Aureobasidium pullans* IFO 4466 strain.

The source of β-1,3-1,6-glucans as instantly claimed is not seen to result in a patentably distinguishable chemical structure. Applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention in such a way as to distinguish the instant invention over the prior art. The asserted

characteristics differentiating the instantly claimed β-1,3-1,6-glucans from glucans obtained from other strains of Aureobasidium is not recited in the claims. Since the Office does not have the facilities for preparing the claimed materials and comparing when with prior art inventions, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

8. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shinohara et al. JP 62-205008 A (Shinohara).

Shinohara discloses glucans having β-1,3-1,6 bonds produced by liquid cultivation of an *Aureobasidium* species. See Abstract. Shinohara discloses that these glucans have improved film-forming, humectant, nonblocking, dispersing, nonadhesive, anti-inflammatory and nontoxic properties and thus can be used in cosmetics.

The source of β-1,3-1,6-glucans as instantly claimed is not seen to result in a patentably distinguishable chemical structure. Applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention in such a way as to distinguish the instant invention over the prior art. The asserted characteristics differentiating the instantly claimed β-1,3-1,6-glucans from glucans obtained from other strains of Aureobasidium is not recited in the claims. Since the Office does not have the facilities for preparing the claimed materials and comparing when with prior art inventions, the burden is on applicant to show a novel or unobvious

difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

9. Claims 1 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hasegawa et al. JP 06-146036 A (Hasegawa).

Hasegawa discloses that β-1,3-glucans produced by microorganisms belonging to the genus Aureobasidium can be used as a metal surface detergent. See Abstract. In particular, Hasegawa discloses that these β-1,3-gluclans are β-1,3-1,6-glucans. See Formulae 1-4 of the specification.

The source of β-1,3-1,6-glucans as instantly claimed is not seen to result in a patentably distinguishable chemical structure. Applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention in such a way as to distinguish the instant invention over the prior art. The asserted characteristics differentiating the instantly claimed β-1,3-1,6-glucans from glucans obtained from other strains of Aureobasidium is not recited in the claims. Since the Office does not have the facilities for preparing the claimed materials and comparing when with prior art inventions, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

In regards limitations drawn to an intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

10. Claims 1, 3, and 5-23 are pending. Claims 1, 9-11, 13-15, and 22-23 are rejected. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 16-21 are drawn to a nonelected invention. Claims 3 and 5-8 are allowed.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 571-272-0655. The examiner can normally be reached on Monday - Friday between 10 am - 2 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner
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